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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/940,773	08/28/2001	Masaaki Ohashi	1007-011	6753

7590

08/05/2004

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EXAMINER

ZIRKER, DANIEL R

ART UNIT

PAPER NUMBER

1771

DATE MAILED: 08/05/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

Applicant(s)

Examiner

Group Art Unit

— The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE -3- MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- ☒ Responsive to communication(s) filed on 4/30/04
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

### Disposition of Claims

- ☒ Claim(s) 8, 10-16, 21, 22 is/are pending in the application.
- ☐ Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- ☒ Claim(s) 8, 13-16, 21, 22 is/are rejected.
- ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- ☐ Claim(s) \_\_\_\_\_ are subject to restriction or election requirement

### Application Papers

- ☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119 (a)-(d).
- ☐ All ☐ Some\* ☐ None of the:
  - ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_
  - ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a))

\*Certified copies not received: \_\_\_\_\_

### Attachment(s)

- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_
- ☐ Interview Summary, PTO-413
- ☐ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Other \_\_\_\_\_

Office Action Summary

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

2. Claims 8, 13-16, 21 and 22 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. More particularly, in each of applicant's independent claims the Examiner respectfully submits that it is not clear what constitutes the subject matter that applicant is claiming. That is, the claim appears to be directed to a "peeling member" but the accompanying language "arranged in contact with or adjacent to a roller attached to an electrophotographic apparatus" and further on wherein (e.g. claim 8) the phrase "where the metal plate contacts or is adjacent to the roller" would seem to clearly imply that an apparatus comprised of several elements is being claimed. Finally, with respect to the independent claims, the phrase (claim 8) "a peeling sheet adhered to said metal support member with YAG laser spot welding" is vague and indefinite in that it does not state whether the metal plate or the polytetrafluoroethylene sheet of the peeling sheet is adhered to the metal support member; it is strongly believed that the two metal layer elements are welded together with YAG laser spot welding, as applicant has stated on at least one occasion. Clarification is requested. In claim 15,

Art Unit 1771

line 3, "metal" is believed to be --metallic--, and claim 21 in its present state appears to essentially be a duplicate of the structure which already exists in claim 8 regarding the polytetrafluoroethylene film.

3. Claims 8, 13-16, and 21 are rejected under 35 U.S.C. § 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. More particularly, as applicant argues (e.g. Response, page 5, fifth paragraph; page 8, third complete paragraph), the newly presented limitation found in independent claim 8 that the PTFE film is a "sheet shaped film" which applicant states (Response, page 5, fifth paragraph, page 8, third complete paragraph) is intended to point out that the polytetrafluoroethylene layer is in the "shape of a sheet which is applied to the metal support plate in order to point out that the film is applied as a solid shaped sheet and is not a film that results from a coating operation". Additionally the remarks further continue on that Figure 3 shows such a shaped sheet on a peeling sheet. However, the Examiner respectfully submits that this limitation appears to be new matter, since it appears to be a variation of the language "free of" a certain element which has

Art Unit 1771

been stated in Ex parte Grasselli et al., Board of Appeals 231 USPQ 393, affirmed CAFC 738 F. 2d 453 (Fed. Cir. 1984) to the effect that such limitations as free of a particular element are new matter unless expressly set forth in the disclosure of the invention. That is, applicant cannot rely upon a particular disclosed embodiment such as applicant here appears to have done by reliance on his Figure 3 to provide proper express support. Stated perhaps differently, such an embodiment is not suitable according to Grasselli for disclosing proper inherent support for the claimed limitation. The Examiner further notes that this limitation appears to be lacking from newly presented claim 22 and wonders whether or not this limitation which applicant appears to have stated in his response is necessary to claim the claimed invention as set forth in claim 22. Clarification is requested.

4. The Examiner has withdrawn the prior art rejection of record based upon applicants' remarks. Additionally, the Examiner would like to note that upon reconsideration the prior attachment in the form of a declaration showing what appears to be superior results from the use of YAG laser welding method appears to show unexpected results with respect to the type of welding employed.

5. Any inquiry concerning this communication or earlier

Serial No. 09/940,773

-5-

Art Unit 1771

communications from the examiner should be directed to Daniel Zirker whose telephone number is (571) 272-1486. The examiner can normally be reached on Monday-Thursday from 8:30 A.M. to 6:00 P.M. The examiner can also be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris, can be reached on (571) 272-1478. The fax phone number for this Group is (703) 872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either private PAIR or public PAIR. Status information for unpublished applications is available through private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Dzirker:cdc

August 2, 2004

DANIEL ZIRKER  
PRIMARY EXAMINER  
GROUP ~~1900~~  
1700

*Daniel Zirker*